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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,712	12/10/2004	Roberto Dalla Valle	58009-019001	9144
<div>Pablo E Tapia Greenberg Traurig 2450 Colorado Avenue Suite 400E Santa Monica, CA 90404</div>				
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<div>EXAMINER SAFAVI, MICHAEL</div>				
<div>ART UNIT 3637</div>				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,712

Applicant(s)

DALLA VALLE, ROBERTO

Examiner

MICHAEL SAFAVI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,12-17 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,12,13,15-17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 03, 2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 12, 13, 15-17, and 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant disclosure had not originally presented "reinforcing the irregularities and cracks" or "polishing the panel...while retaining the irregularities and cracks", (**claim 10**). The instant disclosure had not originally presented "reinforcing the irregularities and cracks" or "polishing the panel...but retaining the irregularities and cracks", (**claim 16**). The instant disclosure had not originally presented "the method consisting essentially of the steps of..." or "reinforcing the irregularities and cracks" or "polishing the panel...while

retaining the irregularities and cracks", (**claim 21**). The instant disclosure had not originally presented "is vibration and vacuum pressed without further artificially creating irregularities and cracks", (**claim 22**).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22, lines 2-3, it is not clear as to what is being defined by the language "is vibration and vacuum pressed without further artificially creating irregularities and cracks" particularly, since the instant disclosure does not clearly set forth how the mix is vibration and vacuum pressed "without further artificially creating irregularities and cracks".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 13, 16, 17, 20, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin '030, Yukawa et al. '508, and United Kingdom reference 1,127,296, (UK '296) and further in view of Edwardes et al. '466.

As for **claims 10, 16, 17, and 20-22**, the instant Background of the Invention discloses as old and well known in the art the claimed invention, including vibration and vacuum pressing the panel, except for the process of separating the second layer of polyethylene-coated paper from the panel by lifting and removing the second layer of polyethylene-coated paper "substantially in a single piece" to produce cracks or "micro-cracks".

However, each of Baskin '030, Yukawa et al. '508, and United Kingdom reference '296 teach application and utilization of a polyethylene sheet material forming a covering during a molding operation forming a stone material with subsequent removal of the polyethylene sheet. Each of Baskin '030 and Yukawa et al. '508 teach application to a resin stone-like material with subsequent removal substantially in a single piece while UK '296 describes use of a polyethylene coated paper in substantially a single piece, col. 4, line 61 of Baskin '030, col. 6, lines 55-67 of Yukawa et al. '508, and page 2, lines 46-48 of UK '296.

Further, Edwards et al. teaches formation of a simulated stone slab as by forming minute cracks and fissures and recesses in the slab utilizing a layer 12/13 that is

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separated from the resulting stone panel in a single piece, col. 3, lines 29-52, (see also, col. 4, lines 30-37).

Therefore, to have formed the synthetic resin stone-like sheet described within the instant Background of the Invention as by applying the polyethylene coated paper sheet and subsequently removing the sheet in substantially a single piece while forming cracks or "micro-cracks", thus allowing for easy processing of the resulting artificial stone panel, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Baskin '030, Yukawa et al. '508, and United Kingdom reference 1,127,296 and further in view of Edwardes.

As for the recitation "polishing the panel to obtain an impermeable surface layer on the antique-look surface of the panel, the instant Background of the Invention discloses as old and well known the process of polishing an artificial stone material.

As for **claim 13**, the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene.

Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin '030, Yukawa et al. '508, and United Kingdom reference 1,127,296, (UK '296) when considering Edwardes et al. '466, as applied to claims 10, 13, 16, 17, and 20 above, and further in view of any of Orsini '510,

Rostoker '172, Sakai '458, and Hoesch '401 when considering either of Lemelson '905, and Ballhausen '474.

The process of forming a stone slab as realized by the instant Background of the Invention in view of any of Baskin '030, Yukawa et al. '508, and UK '296 when considering Edwardes does not particularly include a step of polishing the resulting stone as by grinding with titanium grinding wheels.

However, each of Orsini '510, Rostoker '172, Sakai '458, and Hoesch '401 teach polishing of a synthetic stone-like slab as by grinding an outer surface thereof, (col. 4, line 45 of Orsini '510, col. 2, lines 11-13 of Rostoker '172, col. 8, lines 16-25 of Sakai '458, and col. 3, lines 15-17 of Hoesch '401), while either of Lemelson '905 and Ballhausen '474 teach as old and well known utilization of titanium grinding wheels for polishing natural or artificial stone elements, (col. 3, lines 10-13 and 24-28 of Lemelson '905 and col. 1, line 18-30 and col. 2, lines 2-10 of Ballhausen '474).

Therefore, to have subsequently polished the resulting synthetic stone panel of the modified process of the instant Background of the Invention, thus achieving an aesthetically accurate and pleasing appearance to the stone slab, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Orsini '510, Rostoker '172, Sakai '458, and Hoesch '401 when further considering either of Lemelson '905, and Ballhausen '474.

As for **claim 15**, the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin '030, Yukawa et al. '508, and United Kingdom reference 1,127,296, (UK '296) when considering Edwardes et al. '466, as applied to claims 10, 13, 16, 17, and 20 above, and further in view of any of Hare '224, Reed et al. '335, and Rottger et al. '953.

Though the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, each of Hare '224, Reed et al. '335, and Rottger et al. '953 teach application of polyethylene to a paper sheet as by spraying, (col. 3, lines 65-68 of Hare '224, col. 2, lines 16-20 of Reed et al. '335, and col. 1, line 67 to col. 2, line 6 of Rottger et al. '953).

Therefore, to have utilized a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, thus realizing any and all advantages of such a coated sheet, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Hare '224, Reed et al. '335, and Rottger et al. '953.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art process disclosed within the instant Background of the Invention in view of any of Baskin '030, Yukawa et al. '508, and United Kingdom reference 1,127,296, (UK '296) when considering Edwardes et al. '466, and any of Orsini

'510, Rostoker '172, Sakai '458, and Hoesch '401 and either of Lemelson '905, and Ballhausen '474 as applied to claims 12 and 15 above and further in view of any of Hare '224, Reed et al. '335, and Rottger et al. '953.

Though the instant Background of the Invention discloses as old and well known the process of utilizing a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, each of Hare '224, Reed et al. '335, and Rottger et al. '953 teach application of polyethylene to a paper sheet as by spraying, (col. 3, lines 65-68 of Hare '224, col. 2, lines 16-20 of Reed et al. '335, and col. 1, line 67 to col. 2, line 6 of Rottger et al. '953).

Therefore, to have utilized a polyethylene-coated paper sheet, which has been formed by coating the paper with sprayed polyethylene, thus realizing any and all advantages of such a coated sheet, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of Hare '224, Reed et al. '335, and Rottger et al. '953.

Response to Arguments

Applicant's arguments filed August 03, 2009 have been fully considered but they are not persuasive. Applicant argues "vibration and vacuum pressing" versus "pressure rolling process". However, the obvious modifications presented within the above rejections do not find any distinction between either of a "vibration and vacuum pressing" or a "pressure rolling process". And examiner can only disagree that "an embossed patterned surface is still distinctly different from a surface with natural looking

irregularities” particularly, with Baskin teaching formation of simulated stone products. It is not clear that “unique” slabs form part of the instantly disclosed invention. In any event, the claims appear directed to a process of forming a single slab.

With regard to Applicant’s argument found on page 7 of the response, the above rejection of claims 10, 16 and 21 does present a reason for “separating the second layer of polyethylene-coated paper from the panel by lifting and removing the second layer of polyethylene-coated paper substantially in a single piece”. Further, as expressed within *KSR International Co. vs. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), when an application simply arranges old process steps with each performing the same purpose it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious. The question to be answered is whether the claimed invention is a product of innovation or merely the result of common sense, ordinary creativity, and ordinary skill.

Fact that claimed combination of elements was “obvious to try” might show that such combination was obvious under 35 U.S.C. §103, since, if there is design need or market pressure to solve problem, and there are finite number of identified, predictable solutions, person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation, *KSR International Co. vs. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Contrary to Applicant's assertion, the references to Baskin, Yukawa et al., UK '296 and Edwardes et al. are of the same field namely, casting a plastic, (resin cementitious, etc.), material in the formation of a panel. The applied prior art does more than give general guidance. The prior art sets forth a specific procedural step that is employed in the manufacture of synthetic or plastic panels.

As for Applicant's arguments on page 7 of the response, it is not seen what the differences would be between polishing to render the panel less porous and polishing to impart a gloss. In any event, language found at lines 20-21 of claim 16 is directed to a desired result. With the above modifications reproducing the claimed method steps any recited desired result would be effected minus a showing otherwise. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971):

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

The above rejections of claims 10, 16 and 21 present a method of forming a slab of agglomerate stone including use of a polyethylene-coated sheet which is eventually removed from the formed slab "in substantially a single piece". Therefore, the resulting panel would possess the same characteristics as that resulting from the instantly claimed method. The instant claims do not present any method steps above and beyond those method steps defined within the proposed rejections of the instant claims. As such, the instant claims would not serve to define any particular method step that

might impart any such distinct characteristics to the resulting panel which might differ from a resulting panel formed by the method steps defined within the proposed rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL SAFAVI whose telephone number is (571)272-7046. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Safavi/
Primary Examiner, Art Unit 3637

M. Safavi
October 10, 2009